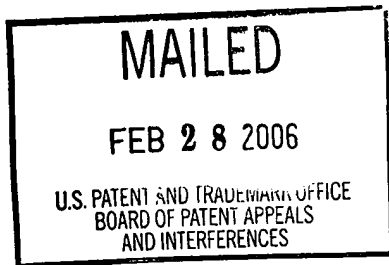


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAVI GANESAN, TIMOTHY SCOTT RENSHAW
and PETER KIGHT



Appeal No. 2005-2744
Application No. 09/849,979

HEARD: FEBRUARY 7, 2006

Before GROSS, BLANKENSHIP and NAPPI, **Administrative Patent Judges.**
NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 58 through 81. For the reasons stated *infra* we sustain the examiner's rejection of claims 58, 60 through 62, 65, 67, 69, 71 through 73, 76, 78, 80 and 81. However, we will not sustain the examiner's rejection of claims 59, 63, 64, 66, 68, 70, 74, 75, 77 and 79. Further, we enter a new grounds of rejection against claims 59, 70 and 81.

THE INVENTION

The invention relates to a method of including a monetary gift with an electronic greeting card.

Claim 58 is representative of the invention and is reproduced below:

58. A method for making a monetary gift, comprising;
- receiving, via a network, a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a recipient;
 - processing the received request to generate the electronic greeting card including a notification of the monetary gift;
 - transmitting, via the network, the generated electronic greeting card to the designated recipient; and
 - directing a crediting of funds equal to the monetary gift amount to a deposit account.

THE REFERENCES

The references relied upon by the examiner are:

| | | |
|-----------|-----------|---------------|
| Van Dusen | 6,175,823 | Jan. 16, 2001 |
| Albrecht | 5,984,180 | Nov. 16, 1999 |

Lenhat, "' Happy Holidays,' High-Tech Style; Sending Cards Over the Internet Gains Popularity", Washington Post (December 20, 1998).

Wijnen, "You've Got Money!", Bank Technology News (June 2000).

"Person-To-anywhere Payments Are Here with Citibanks' C2it", Credit Card News (November 15, 2000).

THE REJECTIONS AT ISSUE

Claims 58, 63, 65 through 69 and 74 through 79 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Van Dusen. Claims 58, 65, 67 through 69, 75, 76, 79 and 80 stand rejected under 35 U.S.C. § 103 as being unpatentable over Van Dusen in view of Lenhart. Claims 59 through 62, 64 and 70 through 73 stand rejected under 35 U.S.C. § 103 as being unpatentable over Van Dusen in view of Albrecht. Claims 59 through 62, 64 and 70 through 73 stand rejected under 35 U.S.C. § 103 as being unpatentable over Van Dusen in view of Lenhart and Albrecht. Claim 81 is rejected as being unpatentable over Van Dusen in view of Lenhart and Official Notice (the articles Wijnen, and "Person-To-anywhere Payments Are Here With Citibanks' C2it" were submitted to support the facts noticed by the examiner). Throughout the opinion we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, for the reasons stated *infra* we sustain the examiner's rejection of claims 58, 60 through 62, 65, 67, 69, 71 through 73, 76, 78, 80 and 81. However, we will not sustain the examiner's rejection of claims 59, 63, 64, 66, 68, 70, 74, 75, 77 and 79.

**Rejection of claims 58, 63, 65 through 69 and 74 through 79 under
35 U.S.C. § 102 (e)**

Claims 58, 65, 69 and 76

Appellants argue that claims 58 and 69 recite limitations requiring the generation of an electronic greeting card including a notification of the monetary gift and that the term "electronic greeting card" has a special meaning. (Brief page 8). As such, appellants argue Van Dusen's message "Happy Birthday Mom!" does not make Van Dusen's message the equivalent to an electronic greeting card. (Brief pages 8 and 9). Appellants state, on page 9 of the brief:

Exemplary electronic greeting cards are currently available at numerous Web sites, some of which have been in operation now for many years, and the phrase "electronic greeting card(s)", also known as "e-card(s)" is a term or art, which has an established and well known meaning to those skilled in the art. The phrase "electronic greeting cards(s)" is defined in the TechEncyclopedia, hosted by TechWeb at techweb.com/encyclopedia/defineterm?term=e-card, to be a particular type of message that "in addition to your own text, e-cards allow different backgrounds, images and music to be used." (emphasis added). Indeed, a similar description of an "electronic greeting card" is found in the Lenhart reference, which is also applied in finally rejecting claims of this application. Thus, an "electronic greeting card" is understood by those skilled in the art to be the electronic equivalent to a paper greeting card.

Appellants assert that Van Dusen teaches an e-mail text message and though Van Dusen's text message might be similar to that enclosed in an electronic greeting card, the similarity does not make the e-mail an electronic greeting card. (Brief page 10). Appellants present similar arguments on page 3 through 6 of the reply brief.

The examiner in response argues, on page 3 of the answer, that appellants' specification "provides that '[t]he e-card site sends the e-card to the recipient via e-mail. As discussed above, the e-mail may be the entire e-card...'(specification, p. 67 lines 13-15, emphasis added. Van Dusen's 'email based gift certificate' (col. 6, lines 8-9) therefore teaches Applicant's electronic greeting card."

We concur with the examiner's claim interpretation. Claims will be given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification will not be read into the claims. *In re Etter* 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). In analyzing the scope of the claim, office personnel must rely on the appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). "[I]nterpreting what is *meant* by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'" (emphasis original) *In re Cruciferous Sprout Litigation*,

301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing *Intervet America Inc v. Kee-Vet Laboratories Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)).

Initially, we note appellants' arguments rely on extrinsic evidence such as the TechEncyclopedia, to provide guidance as to how to interpret the limitation of an "electronic greeting card". We decline to adopt the definition from TechEncyclopedia as there is no date associated with the definition so we are unable to ascertain if the definition was applicable as of the filing date of the application. Additionally, our reviewing court has stated that they view "extrinsic evidence in general as less reliable than the patent and its prosecution history in determining how to read claim terms, for several reasons. First, extrinsic evidence by definition is not part of the patent and does not have the specification's virtue of being created at the time of patent prosecution for the purpose of explaining the patent's scope and meaning" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1308 75 USPQ2d 1321, 1330 (Fed. Cir. 2005). Further, the definition in TechEncyclopedia does not define what is and what is not an e-card. The definition only identifies that other features in addition to text that are allowed to be used, and as appellants' disclosure identifies that the electronic greeting card can be the e-mail message itself, it follows that the format of an e-mail message also allows the use of the additional features.

Appellants' specification states on page 62:

The presentation of the e-card may be accomplished in one of at least two ways, as will also be understood by one skilled in the art. In a first way, the e-mail message sent to the recipient may comprise the entire e-card. That is, the e-mail message is the e-card. Or, in a second way, the e-mail may contain a hyper-link back to the processing agent 130. By following this link, the e-card is displayed to the recipient via a unique web page.

The contents of the e-card, whether presented to the recipient in the first way or the second way, inform the recipient that he has received a gift, as well convey any additional text specified by the donor. The e-card may contain text informing the recipient of the amount of the gift payment and the identity of the donor.

We find no disclosure in appellants' specification that an e-card may contain a background, images or music as argued is known in the art and alleged by reference to the TechEncyclopedia document. Rather, appellants' specification appears to identify the key feature of the e-card is that it conveys a message to the recipient concerning a gift and additional text. Further, we note that even if we were to accept appellants' asserted definition, the definition can not be applied to identify that which is and is not an e-card as it identifies features which may be in an e-card, not features which make the e-card unique from other electronic messages. Thus, we find that the scope of the limitation of an "electronic greeting card including a notification of the monetary gift" as including an e-mail message¹ which contains a text message. We do not find that the

¹ Note to avoid confusion, we refer to "e-mail" as a system to deliver messages and "e-mail message" to refer to individual documents delivered by e-mail.

scope of the limitation is narrowed to the e-card having additional features such as a background, images or music.

The examiner has found that Van Dusen teaches, as shown in figure 2, an e-mail message which contains a text message and includes the notification of a gift. We concur with the examiner's findings. As stated *supra* we consider the scope of the claim 1 limitation "electronic greeting card including a notification of the monetary gift" to include such an e-mail message. Further, we note that Van Dusen teaches in column 4, lines 4 through 6, that the e-mail message may contain a hyperlink which is displayed as a graphical image. Thus, we find that Van Dusen teaches that the e-mail message may contain images, and as such would also meet the more narrow definition of e-card asserted by appellants', i.e. Van Dusen's e-mail message allows "in addition to you own text... different ...images ... to be used." For the forgoing reasons we sustain the examiner's rejection of claims 58 and 69 under 35 U.S.C. § 102 (e). Appellants have presented no arguments directed to claims 65 and 76 which depend upon claims 58 and 69. Accordingly, we sustain the examiner's rejection of claims 65 and 76 under 35 U.S.C. § 102 (e) for the reasons stated with respect to claims 58 and 69.

Claims 63 and 74.

On page 9 of the brief, appellants argue that Van Dusen does not teach further transmitting the electronic greeting card to a non-designated recipient as is recited in claims 63 and 74. Appellants argue that the teachings of Van Dusen, which the examiner is relying upon, do not teach re-transmitting the electronic greeting card, but rather allowing the recipient to designate an account to which the money should be applied.

We concur with appellants for the reasons stated on page 9 of the reply brief. Claim 63 includes the limitation of “further transmitting, via the network, the transmitted electronic greeting card including the hyper-link and the notification of the monetary gift to a non-designated recipient.” Claim 74 contains a similar limitation. The examiner states, on pages 4 and 5 of the answer, “Van Dusen also provides that its email greeting card may be sent to multiple, non-designated recipient accounts” and that this feature meets the “further transmitting feature.” We disagree with the examiner’s assertion. The independent claims identify that the designation of the recipient, the e-mail address, is made by the donor, the scenario the examiner relies upon does not change the recipient of the e-mail message, but rather allows the recipient to select one of the multiple accounts associated with the e-mail address that should be credited with the money from the gift. Accordingly, we will not sustain the examiner’s rejection of claims 63 and 74 under 35 U.S.C. § 102 (e).

Claim 75.

Claim 75 includes the limitation “the payment account associated with the donor is directed to be debited at a time subsequent to an activation of a hyper-link included in the transmitted electronic greeting card.” On pages 5 and 6 of the answer, the examiner asserts “As expressly stated in Van Dusen ‘[w]hen the recipient selects this hyperlink 30, the claim code is conveyed to the Web site ... and is used by the site to automatically identify and credit the recipient’s personal account.’ (Col. 4, lines 15-20).” Appellants argue on page 11 of the reply brief, that the examiner overlooks “the difference between debiting a donors account and crediting a designated recipient’s account.” We concur with appellants. We find that section of Van Dusen cited by the examiner teaches crediting of the recipient’s account after activating the hyper-link, not debiting the donor’s account after activation of the hyper-link. We do not find that Van Dusen teaches debiting the donor’s account subsequent to activation of the hyper-link. Accordingly we will not sustain the examiner’s rejection of claim 75 under 35 U.S.C. § 102 (e).

Claims 66 and 77.

Claim 66 recites the limitation “wherein the request is received from an electronic greeting card service.” Claim 77 contains a similar limitation. The examiner asserts, on page 6 of the answer:

The Examiner submits this language reads on the simple command that is issued when Van Dusen transmits a purchased email greeting card. This is because sending the email greeting card to the recipient requires the greeting card service to submit a request to the recipient’s Internet service provider such that the greeting card is delivered to the recipient.

Appellants argue, on page 12 of the reply brief, that the examiner’s position overlooks “the claim’s requirement that the request received from the electronic greeting service must be processed to generate an electronic greeting card having a notification of the monetary gift.” We concur with appellants. Claim 66 depends upon claim 58 which requires the “processing the received request to generate the electronic greeting card including a notification of the monetary gift.” The example cited by the examiner does not present evidence of how the recipient’s Internet Service Provider (ISP) generates the greeting card, rather it appears from the examiner’s example that the ISP merely forwards the electronic greeting card. Accordingly, we will not sustain the examiner’s rejection of claims 66 and 77 under 35 U.S.C. § 102 (e).

Claims 67 and 78.

Appellants argue, on pages 13 of the reply brief:

[T]he examiner has failed to identify any teaching or suggestion within Van Dusen (and it is respectfully submitted that there is none) of an electronic greeting card service [i.e. a particular type of first entity] receiving the request, generating the electronic greeting including the notification of the monetary gift, and (iii) transmitting the generated electronic greeting to the designated recipient, and also of a payment service [i.e. a particular type of second entity and not the electronic greeting card service] directing the crediting the gift amount to the deposit account.

We disagree with appellants. As stated *supra* with respect to claim 58, we find that Van Dusen does teach the generation of electronic greeting card with the notification of a monetary gift. We consider the entity, Amazon.com, which generates the electronic greeting card to meet the claimed “electronic greeting card service.” Further, we note that claim 58, recites the limitation “crediting of funds equal to the monetary gift amount to a deposit account.” Claim 58 does not identify if the beneficiary of the deposit account is the donor, recipient or electronic greeting card service. Claim 67 adds the limitation “crediting of funds is directed by a payment service provider” thus identifying that the funds are credited by a fourth entity (a payment service provider). Thus, we consider the scope of claim 67 to be broad and include crediting funds by a payment service provider into a deposit account of either the recipient or the electronic greeting card service. We find that Van Dusen teaches that the donor can pay for the gift certificate by credit card. See column 3, lines 57 through 60. We consider the

credit transaction necessarily requires debiting a donor's credit card and crediting of the merchant's account. Thus, we find Van Dusen teaches that a payment service provider, the credit card company, is instructed to credit funds to the greeting card service's deposit. Accordingly, we sustain the examiner's rejection of claims 67 and 78 under 35 U.S.C. § 102 (e).

Claims 68 and 79.

Claim 68 contains the limitation of "transmitting, via the network, the generated electronic greeting card to an electronic greeting card service prior to transmitting the electronic greeting card to the designated recipient." Claim 79 contains similar limitations. Appellants argue, on page 14 of the reply brief, that the examiner's position that the donor generate the electronic greeting card and forward it to the sponsoring merchant is contrary to the teachings of Van Dusen. We concur with appellants. The examiner states, on page 7 of the answer, that a person using Van Dusen's system creates the electronic greeting card by filling out the form shown in figure 1 and that this form is then forwarded to the electronic greeting card service, amazon.com. We disagree with the examiner's rationale. Claim 68 depends upon claim 58, claim 58 recites steps of receiving a request and processing the request to generate an electronic greeting card, i.e. a request is made and transmitted to be processed. Claim 68 further identifies that the processed electronic greeting card is transmitted to an electronic greeting card service prior to transmission to the recipient. Initially, we consider that one

skilled in the art would consider the form in Van Dusen's figure 2 to be used in the requesting step and not the step of generating the electronic greeting card as asserted by the examiner. Nonetheless, applying the examiner's rationale fails to teach the limitations of the claim, because considering completing the form of figure 2 to be the step of generating the electronic greeting card, Van Dusen then has no step equivalent to the claimed "receiving ... a request to send an electronic greeting card." Accordingly, we will not sustain the examiner's rejection of claims 68 and 79 under 35 U.S.C. § 102 (e).

Rejection of claims 58, 65, 67 through 69 and 75, 76, 79 and 80 under 35 U.S.C. § 103 as being unpatentable over Van Dusen in view of Lenhart.

Claim 80

Appellants, argue on pages 15 through 17 of the brief, that Van Dusen does not teach generating an electronic greeting card as recited in claim 80. Further, appellants argue, that while Lenhart does generally teach electronic greeting cards, Lenhart does not teach or suggest electronic greeting cards with monetary gifts.

We disagree with appellants. As stated *supra*, with respect to the rejection of claim 58 under 35 U.S.C. § 102 (e), we consider the scope of the claim term electronic greeting card to encompass Van Dusen's teaching of an e-mail message. Further, as anticipation is the epitome of obviousness, we sustain the examiner's rejection of claim 80 under 35 U.S.C. § 103.

Claims 58, 65, 67 through 69, 75 and 79

On page 17 of the reply brief appellants state “based upon the arguments and evidence presented above with respect to the anticipation rejection of claims 58, 65, 67-69, 75 and 79, ... the Examiner has also failed to establish a prima facie basis for the obviousness rejection of claims 58, 65, 67-69, 75-76 and 79.”

As stated *supra*, we sustain the examiner’s anticipation rejection of claims 58, 65, 67, 69, and 76 and we reverse the examiner’s anticipation rejection of claims 68, 75 and 79. Accordingly, we sustain the examiner’s obviousness rejection of rejection of claims 58, 65, 67, 69, and 76 and we reverse the examiner’s obviousness rejection of claims 68, 75 and 79 for the reasons stated *supra* with respect to the respective anticipation rejections.

**Rejection of claims 59 through 62, 64, 70-73 under
35 U.S.C. § 103 as being unpatentable over Van Dusen in view of Albrecht
and the Alternative Rejection of claims 59 through 62, 64, 70-73 under
35 U.S.C. § 103 as being unpatentable Van Dusen in view of Albrecht and
Lenhart.**

Claims 59 and 70.

Claim 59 includes the limitation “the electronic greeting card is transmitted to the designated recipient at one of 1) a time subsequent to the directing of the crediting of the funds to the deposit account, and 2) a time concurrent with the directing of the crediting of the funds to the deposit account.” Claim 70 contains similar limitations. Appellants argue, on pages 17 and 18 of the brief, that neither Van Dusen, Albrecht or Lenhart teach these limitations. The examiner, citing no evidence, maintains that changing the sequence of billing in Van Dusen is obvious.

We disagree with both the examiner and the appellants. Claim 59 is dependent upon claim 58. As discussed *supra*, claim 58 does not identify the beneficiary of the deposit account and we consider claim 58 to be broad enough to encompass crediting funds into deposit accounts of either the recipient or the electronic greeting card service. Additionally, we note that claim 59 is recited in the alternative, thus, we consider the scope of claim 59 to include that a) the electronic gift card is transmitted after crediting the funds into either the recipient’s deposit account or the electronic greeting card service’s deposit account, or b) the electronic greeting card is transmitted concurrent with crediting funds into either the recipient’s deposit account or the electronic

greeting card service's deposit account. We find that Van Dusen teaches that once the order has been paid for the web site sends the email message with the gift certificate. See column 3, lines 60-62. Further, we note that Van Dusen teaches that the donor can pay by credit card. See column 3, line 59. We consider the credit transaction necessarily requires debiting of a donor's credit card and crediting of the electronic greeting card service's (i.e. Amazon.com) account. Thus, we find that Van Dusen teaches that the e-mail message is not sent until after the electronic greeting card service's deposit account is credited and that Van Dusen teaches the limitations of claim 59. However, as our interpretation of claims 59 and 70 and our application of Van Dusen differs from the examiner's rejection, we designate this as a new grounds of rejection for claims 59 and 70.

Claims 60 through 62 and 71 through 73.

Appellants argue on page 18 of the brief and pages 23 through 25 of the reply brief, that the examiner has not shown that one would be motivated to modify Van Dusen to make deposits in deposit accounts at financial intuitions. On page 25 of the reply brief, appellants argue that modifying Van Dusen to credit a deposit account in another institution would violate one of Van Duesn's principles that ensures that the gift certificate amount must be spent on purchases from the sponsoring merchant.

The examiner argues, on page 10 of the answer:

Albrecht is disclosed as an improvement over ordinary monetary gift accounts. Albrecht uses a financial institution to provide a gift recipient with a deposit account that is accepted by any retailer (online or physical) that accepts ordinary credit cards (col. 3, lines 4-6). Based on this disclosure, one skilled in the art would have appreciated the value of giving a gift certificate that could be used to buy items at any retailer that accepts credit cards.

We concur with the examiner. Our reviewing court has stated “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.” *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). When determining obviousness, “[t]he factual inquiry whether to combine references must be thorough and searching.” *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433, *citing McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). “It must be based on objective evidence of record.” *Id.* “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617. “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” *Dembiczak*, 175 F.3d at 999-1000, 50 USPQ2d at 1617, *citing McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). The Federal Circuit states that, “[t]he mere fact that the prior art may be modified in the manner suggested

by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In addition, our reviewing court stated, that when making an obviousness rejection based on combination, "there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by applicant" in *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433 (quoting *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)). The examiner has found that Albrecht provides suggestion to modify systems such as Van Dusen's to allow gift certificates which can be used at multiple merchants. We concur. Albrecht identifies that gift certificates which are good only at the vendor have disadvantages for the purchaser (donor), merchant and recipient. See generally column 1 lines 53 through column 2, lines 37. Albrecht teaches, as an alternative to the store specific gift certificate systems, a system where a purchaser can purchase value in the form of a credit instrument in a separate account at a financial institution, for the gift recipient. See column 2, lines 50-63. Thus, we find that Albrecht provides suggestion to modify the merchant specific gift certificate of Van Dusen to make use of a credit in an account at a financial institution. Accordingly, we sustain the examiner's rejection of claims 60 and 71.

Claims 61, 62, 72 and 73 depend upon claim 60 and 70 respectively. Appellants have presented no arguments directed to these claims. Accordingly, we sustain the examiner's rejection of claims 61, 62, 72 and 73 for the reasons provided with respect to claims 60 and 70

Claim 64.

Claim 64 includes the limitations "debiting a payment account at a financial institute associated with the requesting donor; wherein the payment account associated with the requesting donor is debited at a time subsequent to an activation of a hyper-link included in the transmitted electronic greeting card. Claim 75 contains a similar limitation and as discussed *supra* we do not find that Van Dusen teaches this limitation. We do not find that either Albrecht or Lenhart teach or suggest that the donor's account is debited subsequent to the recipient activating a hyper-link associated with an electronic greeting card. Accordingly, we will not sustain the examiner's rejection of claim 64.

Rejection of Claim 81 under 35 U.S.C. § 103

On page 28 of the brief, appellants assert that the rejection of claim 81 is improper for the reasons discussed with respect to the other claims. On pages 29 and 30 of the reply brief, appellants state that the examiner's position is not understood. Appellants assert:

Claim 81 requires that debiting of funds equal to the monetary gift amount be directed from a deposit account at a financial institution associated with the requesting donor to a deposit account at a financial institution associated with the service provider. The claim also requires that crediting of funds to the deposit account of the designated recipient be directed from the deposit account associated with the service provider.

However, Appellants do not identify how claim 81 differs from the references cited by the examiner.

The examiner states on page 11 of the answer:

Official Notice was taken that the broad limitation, *wherein the funds are directed to be credited to the deposit account from the deposit account associated with the service provider*, was old and well known in the art. Despite its convoluted language, this limitation reads on one bank customer depositing funds into another bank customer's account wherein the customer's belong to the same bank. As demonstrated by the references offered by the Examiner [the articles Wijnen, and "Person-To-anywhere Payments Are Here With Citybanks' C2it] this step is neither new or non-obvious when viewed in light of Van Dusen.

We concur with the examiner's findings. Initially we note, that claim 81 does contain several ambiguities and for the reasons stated *infra* we now reject claim 81 under 35 U.S.C. § 112 second paragraph. Further, we note that claim 81 does not contain limitations directed to crediting the recipient's account from the service provider's account. As stated *supra*, with respect to claim 67, Van Dusen teaches that the donor can pay with a credit card, and that the credit transaction necessarily requires debiting a donor's account and crediting a merchant's account. We note that this function of credit cards is discussed briefly on page 2 of Wijnen ("Business readily establish merchant accounts to process

credit card transactions.) Thus, we find that Van Dusen teaches the limitations of claim 81.

Further, although claim 81 does not include the limitation of crediting a recipient's account, we nonetheless find that Wijnen teaches such a system and provides motivation to incorporate it into a gift certificate system such as Van Dusen. Wijnen teaches that for individuals who do not want the expense of a merchant account an alternative is a person-to person type account. The example discussed is the PayPal system. With the PayPal system a person (customer) registers and has a PayPal account from which they draw off to pay someone else (receiver). If the customer has insufficient funds in the PayPal account, monies are deducted from the consumer's credit card. On the receiving end the receiver can have the monies deposited directly into their bank account. See page 2 of Wijnen. We consider the PayPal account example to teach the debiting and crediting as appellants' argument shows was intended in claim 81. In the PayPal system an account associated with the donor is debited, the customer's credit card account, an account associated with the service provider is credited, the PayPal account. The PayPal account is then debited, and recipient's bank account is credited with funds debited from the service provider's (PayPal) account. Further, we find that Wijnen teaches that the system is an alternative to credit cards and can be used to send monies in electronic greeting cards. See Wijnen page 2 and Wijnen page 3 ("[i]f the bank were to expand the service into the business arena, it would be for enterprises

like a greeting card company, which could enable customers to send money in ecards").

For the forgoing reasons, we sustain the examiner's rejection of claim 81 under 35 U.S.C. § 103.

New, Rejection of claim 81 under 35 U.S.C. § 112 Second Paragraph

We find claim 81 to be ambiguous and now enter a rejection under 35 U.S.C. § 112 second paragraph. Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. ***See In re Venezia***, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). As discussed *supra* claim 58 is does not contain a limitation identifying the beneficiary of the claimed deposit account. Claim 81 depends upon claim 85 and includes limitations directed to a donor's deposit account and a service provider's deposit account. It is not clear if claim 81 recites two or three deposit accounts. Further, the limitation "wherein the funds are directed to be credited to the deposit account from the deposit account associated with the service provider" is ambiguous as it is unclear as to which deposit account is being credited. While, from appellants' arguments it is apparent that appellants intended claim 58 to recite the deposit account is associated with a recipient, and intended claim 81 to recite crediting the deposit account associated with the recipient, claims 58 and 81 contain no such limitations.

Conclusion

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief or reply brief have not been considered and are deemed waived by appellants (see 37 CFR § 41.37(c)(1)(vii)). Support for this rule has been demonstrated by our reviewing court in *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the Federal Circuit stated that because the appellants did not contest the merits of the rejections in his brief to the Federal Circuit, the issue is waived. *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the

examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

In summary we sustain the examiner's rejection of claims 58, 60 through 62, 65, 67, 69, 71 through 73, 76, 78, 80 and 81 however we will not sustain the examiner's rejection of claims 59, 63, 64, 66, 68, 70, 74, 75, 77 and 79. Further, pursuant to 37 CFR § 41.50(b), we enter a new grounds of rejection against claims 59, 70 and 81.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (1) (iv).

AFFIRMED-IN-PART
37 CFR § 41.50(b)

Ante Pellman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Howard B. Markson

HOWARD B. BLANKENSHIP
Administrative Patent Judge


ROBERT E. NAPPI

~~ROBERT E. NAPPI~~
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 2005-2744
Application No. 09/849,979

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